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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/752,624	12/28/2000	Bertram Geck	00 P 9127 US	9439

7590 05/10/2004

Siemens Corporation
Attn: Elsa Keller, Legal Administrator
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EXAMINER	
ELAHEE, MD S	

ART UNIT	PAPER NUMBER
2645	

DATE MAILED: 05/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/752,624	GECK ET AL.	
	Examiner	Art Unit	
	Md S Elahee	2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *03* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1, 2 and 7 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 15 of U.S. Patent No. 6,717,959. Because claims in the co-pending application are broader than the ones in patent, In re Van Ornum and Stang, 214 USPQT61, broad claims in the co-pending application are rejected as obvious double patenting over previously patented narrow claims. For example, the combination of claims 1 and 2 of the co-pending application are the same as claim 1 of the patent except that the first PDN with the Call Appearance information is not being configured. Furthermore, claim 7 of the co-pending application is the same as claim 15 of the patent except that the first PDN with the Call Appearance information is not being configured. Therefore, claims 1 and 7 of the co-pending application is broader than claims 1 and 15 of the patent simultaneously.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claims 1 and 7, recite the phrase 'the same BRI circuit' on page 2, lines 13 and 39 respectively. There is insufficient antecedent basis for this phrase in the claims. Claims 2-6 and 8-20 depend on the rejected claims.

Specification

6. The amendment filed 02/09/04 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the originally disclosed date (SR-4620, Issue 1, December 1996) of the 1999 Version of the Bellcore National ISDN BRI Terminal Equipment (TE) Generic Guidelines has been changed to (SR-4620, Issue 1, December 1998).

Applicant is required to cancel the new matter in the reply to this Office Action.

Applicant should provide the document to support the change if applicant believes that the change is proper.

§ 1.105 - Request for Information

7. Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

8. Regarding claims 1 and 7, the applicant has claimed the limitations 'monitoring the message exchange on the D channel to obtain first Call Appearance information' and 'monitoring means for monitoring message exchange on the D channel to automatically obtain first Call Appearance information' respectively. On the other hand, the specification of the application states the 'Call Appearance information' is a part of the signaling or a routing parameter or a dialing number. Further, in the specification, on page 2, lines 18-22, the applicant has mentioned the 'Call Appearance' feature in the 'The 1999 Version of the Bellcore National ISDN BRI Terminal Equipment (TE) Generic Guidelines has been changed to (SR-4620, Issue 1, December 1996)' document. However, examiner can not locate the disclosed document and no related documents related to using the Call Appearance as claimed were found. Examiner believes that the disclosed Bellcore document is necessary to the examination of the application.

The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

This requirement is an attachment of the enclosed Office action. A complete reply to the enclosed Office action must include a complete reply to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 2, 7, 8, 13 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Sasano et al. (U.S. Patent No. 5,200,994).

Regarding claims 1, 2, 7 and 8, Sasano teaches generating an incoming call (i.e., first call from PDN1 to PDN2) in the same BRI circuit (fig.1, fig.2, fig.8, fig.9; col.1, lines 43-47, col.7, lines 9-13, 63-68, col.8, lines 1-15, 26-30, col.6, lines 1-36)

Sasano further teaches monitoring the message exchange on the D channel to obtain subaddress (i.e., first Call Appearance information) (fig.8, fig.9, fig.13, fig.15, fig.16; col.9, lines 34-37, col.10, lines 7-15, col.11, lines 21-23, col.12, lines 34-46, col.13, lines 53-64).

Regarding claim 13, Sasano teaches that the dialing means and the monitoring means are embodied in a microprocessor (fig.1; col.7, lines 28-33).

Regarding claim 15, Sasano teaches the dialing means and the monitoring means are embodied in an application specific integrated circuit (fig.1; col.7, lines 9-13, 22-33).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. Claims 3-6, 9-12, 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasano et al. (U.S. Patent No. 5,200,994) and in view of Brown et al. (U.S. Patent No. 5,600,654).

Regarding claims 3-6 and 9-12, Sasano fails to teach "putting the first call on hold". Brown teaches putting the first call on hold (col.4, lines 32-51). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Sasano to allow putting the first call on hold as taught by Brown. The motivation for the modification is to have doing so in order to incorporate the steps of identifying the call appearance values in Sasano's system in order to have better instructions for configuring the call appearance values so that customer can follow those steps to identify the call appearance values on his/her CPE by himself/herself besides having them programmed.

Sasano further teaches generating a second call from PDN1 to PDN2 in the same BRI circuit (fig.1, fig.2, fig.8, fig.9; col.1, lines 43-47, col.7, lines 9-13, 63-68, col.8, lines 1-15, 26-30, col.6, lines 1-36)

Sasano further teaches monitoring the message exchange on the D channel to obtain second Call Appearance information (fig.8, fig.9, fig.13, fig.15, fig.16; col.9, lines 34-37, col.10, lines 7-15, col.11, lines 21-23, col.12, lines 34-46, col.13, lines 53-64).

Regarding claims 5, 6, 11 and 12, Sasano fails to teach "putting the call on hold". Brown teaches putting the call on hold (col.4, lines 32-51). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Sasano to allow putting the call on hold as taught by Brown. The motivation for the modification is to have doing so in order to incorporate the steps of identifying the call appearance values in Sasano's system in order to have better instructions for configuring the call appearance values so that customer can follow those steps to identify the call appearance values on his/her CPE by himself/herself besides having them programmed.

Sasano further teaches generating another call (fig.1, fig.2, fig.8, fig.9; col.1, lines 43-47, col.7, lines 9-13, 63-68, col.8, lines 1-15, 26-30, col.6, lines 1-36)

Sasano further teaches monitoring the D channel until the generated call results in a busy signal (fig.8, fig.9, fig.13, fig.15, fig.16; col.9, lines 34-37, col.10, lines 7-15, col.11, lines 21-23, col.12, lines 34-46, col.13, lines 53-64).

Regarding claim 17, Sasano teaches that the dialing means, the monitoring means, the capture means, the holding means, and the repeating means are embodied in a microprocessor (fig.1; col.7, lines 28-33).

Regarding claim 19, Sasano teaches the dialing means, the monitoring means, the capture means, the holding means, and the repeating means are embodied in an application specific integrated circuit (fig.1; col.3, lines 33-47).

13. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sasano et al. (U.S. Patent No. 5,200,994) and in view of Johnson et al. (U.S. Patent No. 6,141,406).

Regarding claim 14, Sasano fails to teach that the dialing means, the monitoring means are embodied in a field programmable gate array. Johnson teaches that the dialing means, the monitoring means are embodied in a field programmable gate array (col.14, lines 50-61, col.15, lines 29-55). Thus, it would have been obvious to one of ordinary skill in the art to modify Sasano to allow the dialing means, the monitoring means to be embodied in a field programmable gate array as taught by Johnson. The motivation for the modification is to incorporate the equipments mentioned above in Sasano's system in order to have a system with better equipments to support testing and configuring the call appearance values.

14. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sasano et al. (U.S. Patent No. 5,200,994) and in view of Hughes-Hartogs (U.S. Patent 5,854,829).

Regarding claim 16, Sasano fails to teach that the dialing means and the monitoring means are embodied in firmware in a PBX switch. Hughes-Hartogs teaches that the dialing means, the monitoring means, the capture means, the holding means and the repeating means are embodied in firmware in a PBX switch (fig.1, PBX 7). Thus, it would have been obvious to one of ordinary skill in the art to modify Sasano to allow the dialing means and the monitoring means to be embodied in firmware in a PBX switch as taught by Johnson. The motivation for the modification is to incorporate the equipments mentioned above in Sasano's system in order to have a system with better equipments to support testing and configuring the call appearance values.

15. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sasano et al. (U.S. Patent No. 5,200,994) and in view of Brown et al. (U.S. Patent No. 5,600,654) and further in view of Johnson et al. (U.S. Patent No. 6,141,406).

Regarding claim 18, Sasano in view of Brown fails to teach that the dialing means, the monitoring means, the capture means, the holding means are embodied in a field programmable gate array. Johnson teaches that the dialing means, the monitoring means, the capture means, the holding means are embodied in a field programmable gate array (col.9, lines 58-67, col.10, lines 1-4, col.14, lines 50-61, col.15, lines 29-55). Thus, it would have been obvious to one of ordinary skill in the art to modify Sasano in view of Brown to allow the dialing means, the monitoring means, the capture means, the holding means to be embodied in a field programmable gate array as taught by Johnson. The motivation for the modification is to incorporate the equipments mentioned above in Sasano's system in order to have a system with better equipments to support testing and configuring the call appearance values.

16. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sasano et al. (U.S. Patent No. 5,200,994) and in view of Brown et al. (U.S. Patent No. 5,600,654) and further in view of Hughes-Hartogs (U.S. Patent 5,854,829).

Regarding claim 20, Sasano in view of Brown fails to teach that the dialing means, the monitoring means, the capture means, the holding means and the repeating means are embodied in firmware in a PBX switch. Hughes-Hartogs teaches that the dialing means, the monitoring means, the capture means, the holding means and the repeating means are embodied in firmware in a PBX switch (fig.1, PBX 7). Thus, it would have been obvious to one of ordinary skill in the art to modify Sasano in view of Brown to allow the dialing means, the monitoring means to be embodied in a field programmable gate array as taught by Johnson. The motivation for the modification is to incorporate the equipments mentioned above in Sasano's system in order to

have a system with better equipments to support testing and configuring the call appearance values.

Response to Arguments

17. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Seraj (U.S. Patent 5,388,095) teaches Representing subscribers in a multiple interface environment switching system and Baker et al. (U.S. Patent 5,719,870) teach Interface arrangement for providing ISDN basic rate interface full channel service.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alam Elahee whose telephone number is (703) 305-4822. The examiner can normally be reached on Mon to Fri from 9:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4750.

M.E.
MD SHAFIUL ALAM ELAHEE
May 3, 2004

FAN TSANG
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